

REMARKS

Reconsideration of the outstanding Office Action is respectfully solicited.

New Claims presented herein are based on the application specification as follows: Claim 17 is based on page 11, lines 16-17. Claim 18 is based on page 11, lines 20 et seq. Claim 19 is based on page 11, line 20 et seq. Claim 20 is based on page 11, line 4. Claim 21 is based on page 11, lines 4 et seq. Claims 22-23 are based on originally filed claims.

Applicants respectfully traverse the rejections of Claims under 35 U.S.C. §112, 102, 103

Applicants respectfully traverse the rejections under 35 U.S.C. §112 . The recitation of formulae in Claims 8, has been amended to exclude compound 14. Moreover, the formula in Claim 8 have been corrected to recite a methylene group instead of a methyl group.

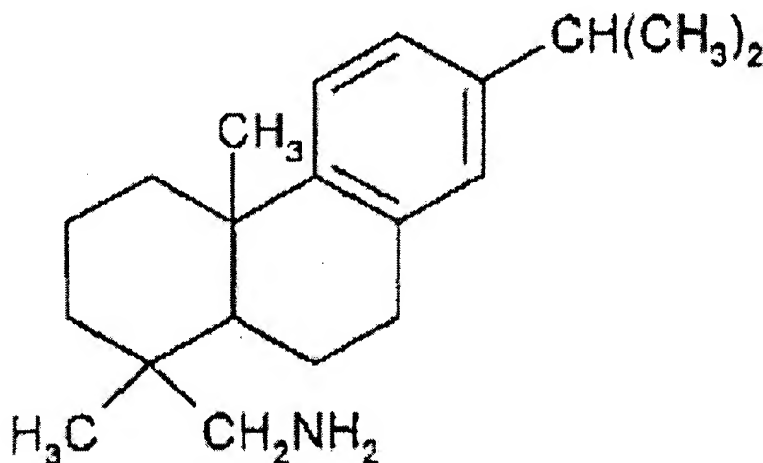
Applicants respectfully traverse the rejections under 35 U.S.C. 102.

The Examiner has cited registries from the Chemical Abstract Service, which are shown in the US Office Action. It is respectfully submitted that the CAS registries do not satisfy the law of anticipation as the CAS registries do not provide enablement of either how to make or how to use. The disclosure requirements defined by case law precedent for a printed publication to constitute an anticipation and thus negate novelty include 'written description' [*In re Arkely*, and *In re Samour*] and 'enablement' [*In re LeGrice*]. In applicants' view, the CAS registries do not satisfy that case law, requiring enablement to place the claimed information in the possession of the public. It is clear that the CAS registries neither enable how to make nor enable how to use the formula recited respectively in each. Accordingly, In applicants' view, the CAS registries do not support a prima facie case of lack of novelty. In applicants' view, there is some doubt as to whether the CAS registries satisfy the 'written description' requirement; on the instant record, the formula of each CAS registry may constitute the 'speculation' addressed in *In re Wiggins*. Accordingly, applicants request withdrawal of the rejections under 35 U.S.C. §102 and reconsideration with respect to new claims.

Applicants respectfully traverse the rejections under 35 U.S.C. §103.

The Examiner has cited US 5,236,493 against claims 11-13, 15, and 16 of the present application. The Examiner states that US'493 discloses the use of amine $R^1-N(R^2)R^3$ for marine biocides in antifouling coatings, where R^1 is a mono-valent hydrocarbon group derived from a diterpene, and R^2 and R^3 are each independently hydrogen, an alkyl group having 1 to 18 carbon atoms, or an aryl group having 6 to 12 carbon atoms. It is stated in column 3, lines 2-18 of US'493 that the amine is preferably derived from Rosin and can be a primary, secondary, or tertiary amine.

The specific example in US'493 listed for use as a marine biocide is Rosin Amine D which has the following chemical structure;



In this case therefore, US'493 teaches R^2 and R^3 are hydrogen radicals.

It is submitted that the compounds claimed for use as a marine biocide in claims 11-13, 15, and 16 in the present application are neither anticipated nor obvious in respect of US'493. US'493 discloses the use of amines where R^2 and R^3 each independently represent hydrogen (as in the above example), an alkyl group having 1 to 8 carbon atoms, or an aryl group having 6 to 12 carbon atoms. In the present application R^1 optionally represents:

- NR^2R^3 , where R^2 represents a hydrogen atom or C1-C8 alkyl, R^3 represents $\text{C}=\text{OR}^4$, wherein R^4 is H or OR^5 or NHR^5 (R^5 being a C1-C8 alkyl or aryl optionally substituted with a halogen);
- $\text{N}=\text{CR}^6\text{R}^7$, where R^6 is H or a C1-C6 alkyl or aryl and R^7 is a C1-C6 alkyl or aryl, each optionally substituted with a halogen; or
- isonitrile, isocyanate, isothiocyanate, or guanidine group

It is submitted that although R^2 in the present application can be hydrogen or C1-8 alkyl, R^3 represents $\text{C}=\text{OR}^4$ which is not disclosed by US'493. A person skilled in the art would not find hydrogen, alkyl groups, or aryl groups (R^3 of US'493) analogous to aldehyde groups, ester groups, or imines. Still further, the remaining groups of the present invention, namely cyano based groups, nitrile based groups, isocyanate groups, guanidine groups etc are neither taught nor disclosed by US'493.

On study of US'493 a skilled man may try other similar substituents in the hope of finding compounds with a similar antifouling effect. However, to suggest that the skilled man would be directed toward the groups in the present application upon reading US'493 with some expectation of an efficacious antifouling effect is simply not reasonable. It is not reasonable to suggest that, due to the teachings contained within US'493, the skilled man would go from the hydrogen, short alkyl, or simple aryl groups to the groups listed in the present application. Indeed, the compounds in the present application are a group of compounds from a genus which constitutes thousands of possible substituents. It would be speculation to predict which of these thousands of substituents would produce required effect on marine organisms. It is therefore submitted that discovery of the desired effect for the selected compounds is inventive over the prior art, and that the skilled man would not equate the use of Rosin Amine A disclosed in US'493 with the entirely different compounds claimed in claims 11-13, 15, and 16-23 of the present application.

It is therefore submitted that the claims are directed to subject matter which is patentable under Sections 102 and 103. Reconsideration and an early allowance are respectfully solicited.

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Respectfully submitted,



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